

## **REMARKS/ARGUMENTS**

In the Office Action mailed July 15, 2009, the Examiner rejected claims 1-23. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 1-23. No new matter has been added. Applicants believe that the new set of claims is patentable. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

### **I. Claim Objection**

The Office Action objected claim 1 for the use of parenthesis. Without acquiescing in this suggestion, Applicants have amended claim 1 as suggested by the Office Action to overcome the objection. No new matter has been added. Withdrawal of the objection is respectfully requested.

### **II. Claim Rejections under 35 USC § 112**

A. The Office Action rejected Claims 7, and 13-16 under 35 USC 112, second paragraph, as being indefinite relative to "R4" of claim 7 and formula D of claim 1. Applicants disagree. However, in the interest of expediting prosecution and without acquiescing in this suggestion, Applicants have amended the language of claim 7 to overcome the rejections.

B. The Office Action rejected Claims 13, 14, and 15 as having insufficient antecedent basis. Applicants disagree. However, in the interest of expediting prosecution and without

acquiescing in this suggestion, Applicants have amended the language of claim 1 to overcome the rejections.

C. The Office Action rejected Claims 1, 3, 15, and 17 as being indefinite for reciting a range within a range. Applicants disagree. However, in the interest of expediting prosecution and without acquiescing in this suggestion, Applicants have amended the language of claims 1, 3, 15, and 17 to overcome the rejections.

D. The Office Action rejected Claims 1 and 23 as being indefinite relative to the phrase "such as." Applicants disagree. However, in the interest of expediting prosecution and without acquiescing in this suggestion, Applicants have amended the language of claims 1 and 23 to overcome the rejections.

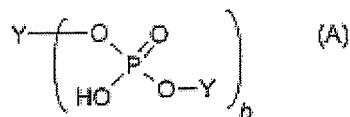
### III. Claim Rejections under 35 USC § 103(a)

The Office Action rejected claims 1-18, 20, and 21 of the present invention under 35 USC § 103(a) as being obvious over Klee et al. (US 6,812,266) in view of Moszner (US 6,172,131). Applicants do not agree with the rejection of claims 1-18, 20, and 21 under § 103.

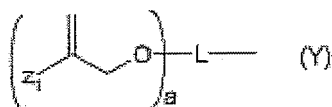
The present invention relates to a one-part self-etching, self-priming dental adhesive composition having a pH of at most 2, which comprises a specific polymerizable acidic phosphoric acid ester monomer of the following formula (A) and a further specific polymerizable acidic monomer selected from the group consisting of (b1), (b2) and (b3). The invention is based on the recognition that the specific polymerizable acidic phosphoric acid ester monomer of formula (A) as defined by the claims is both highly acidic and highly stable under acidic conditions of less than pH 2 despite that fact that the molecules contain a phosphoric acid ester group. Moreover, the specific polymerizable acidic phosphoric acid ester monomer of formula (A) provides a strong increase on the adhesive strength of a composition.

The Office Action suggests that Klee et al. discloses a dental adhesive comprising a polymerizable (meth)acrylamide that comprises at least one inorganic acidic moiety, polymerizable comonomer and polymerization initiator, inhibitor and stabilizer for a hydrolysis stable one-part self-etching, self-priming dental adhesive, however admits that Klee et al. fails to disclose a polymerizable acidic phosphoric acid ester of formula (A). (Office Action Pages 3-4) The Office Action attempts to support a finding of fact by citing the disclosed examples of formula (I) shown in col 7-9 of Moszner. Applicants disagree and kindly invite the Examiner to provide a finding of fact with specificity that Moszner discloses a polymerizable acidic

phosphoric acid ester monomer of the following formula (A):



wherein the moieties Y independent from each other represent a hydrogen atom or a moiety of the following formula (Y)



More specifically, Applicants kindly invite the Examiner to provide a showing that Moszner discloses a polymerizable acidic phosphoric acid ester monomer having the Oxygen components arranged such as the -O-L-O- moiety of formulas (A) and (Y) being Z<sub>1</sub>-CO-C-"O"-L-"O"-(POOYOH).

Applicants believe that the office action has not presented a prima facie case of obviousness. Thus, Applicants respectfully request that the rejections of claims 1-18, 20, 21, and their dependents be withdrawn and the claims allowed.

#### IV. Allowable Claims

The Office Action has not presented a prima facie case of anticipation and/or obviousness as to claims 19, 22, and 23. Thus, Applicants respectfully request that claims 19, 22, and 23 be allowed.

**CONCLUSIONS**

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (717) 849-4461.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 040780 for any fee which may be due.

Dated: 1/19, 2012

Customer No. 23439

Respectfully submitted,

By 

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